

**REMARKS/ARGUMENTS**

Claims 38-40, 42 and 44 were examined. Reexamination and reconsideration of the claims are respectfully requested in view of the following remarks.

The Abstract has been corrected to contain no more than 150 words.

The double patenting rejections are overcome by the submission of a Terminal Disclaimer over commonly owned U.S. Patent No. 6,508,782.

Applicants respectfully traverse the rejection of claims 38-40, 42 and 44 as being obvious over the combination of U.S. Patent No. 5,304,115 to Pflueger, in combination with U.S. Patent No. 5,344,395 to Whalen et al.

The Examiner argues that "Pflueger discloses the claimed invention as described . . . except for a low operating frequency. Whalen '395 suggests low operating frequencies . . . as opposed to ultrasonic frequencies [as taught by Pflueger '115] to avoid the generation of a substantial amount of heat. . . . It would have been obvious to one of ordinary skill in the art to modify the invention of Pflueger '115 to operate at low frequencies, as suggested by Whalen '395, to prevent the unnecessary generation of heat."

Applicants respectfully disagree with this analysis. While Whalen '395 does note the problems associated with heat in ultrasonic catheters (col. 3, lines 19-32), the suggested solution is to eliminate "transverse wire motion" in order to avoid heat build-up for generation (col. 3, lines 65-67). Nowhere in Whalen '395 is it suggested that the catheter should be operated at a low frequency in order to avoid "unnecessary generation of heat" as asserted by the Examiner.

As it is certainly well-known to the Examiner, an obviousness rejection requires not only that the individual limitations of a claim be found in the prior art, but also that prior art or the knowledge of one of ordinary skill in the art provide motivation for combining the references in the manner needed to support the rejection. See, MPEP §2143.

In the present circumstances, the Examiner has failed to provide the necessary motivation for substituting the low frequency operation of Whalen '395 for the ultrasonic operation of Pflueger '115. In particular, the teachings of Whalen '395 would suggest that the

catheter be operated in a way which avoids "transverse wire motion." This suggestion seems entirely inconsistent with independent claim 38 and 42 herein, both of which set forth a rotational motion in the catheter which would be subject to the type of transverse wire motion that Whalen '395 finds undesirable.

For these reasons, Applicants believe that the Examiner has failed to establish *prima facie* obviousness and request that all pending claims be passed to issue at an early date.

As an additional matter, Applicants note that they are submitting an Information Disclosure Statement submitting a number of references that they wish to be made of record herein. Each of these references was considered during prosecution of prior applications in this series of cases.

If for any reason the Examiner believes that a telephone conference would in any way expedite prosecution of the subject application, the Examiner is invited to telephone the undersigned at 650-326-2400.

Respectfully submitted,

  
Lynn M. Thompson  
Reg. No. 47,991

for James M. Heslin  
Reg. No. 29,541

Attachments: *Terminal Disclaimer*  
*Information Disclosure Statement*

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
Tel: 650-326-2400  
Fax: 415-576-0300  
Attachments  
JMH:jke  
60137119 v1